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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,859	04/27/2005	Carlos Portasany Sanchez	P/189-362	4887
2352	7590	11/16/2006	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			KARIKARI, KWASI	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/522,859

Applicant(s)

PORTASANY SANCHEZ, CARLOS

Examiner

Kwasi Karikari

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

### ***Response to Arguments***

2. Applicant's arguments filed 09/01/2006 have been fully considered but they are not persuasive.

In response to Applicant's outstanding argument, with regard to claims 1 and 9, that Nacheff et al. (U.S. 20050207562 A1), (hereinafter Nacheff) fails to teach certain claimed limitations (page 4 of applicant's remarks), the examiner has noticed that Nacheff reference is recited, in the Office Action, only to discuss the applicant's claimed features "an instruction and a requested reference for said array" in claims 1 and 9. Nacheff, indeed, teaches the claimed limitations "an instruction and a requested reference for said array" (see Nacheff, Pars. [0006,0041-44 and 0080-0114]; whereby the interactive display and proactive command are equated with "instruction" and the "requested reference" is equated with the actual act of addition, deleting or modifying of file).

Moreover, the examiner maintains that Applicant Admitted Prior Art (AAPA) teaches the remaining claimed limitations in claims 1 and 9 (see AAPA, background of invention, Pages 1-5). In view of the above, the rejections using AAPA and Nacheff are proper and maintained as set forth below. These rejections are made FINAL.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12 are rejected under U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter AAPA) in view of Nachev et al. (U.S. 20050207562 A1), (hereinafter Nachev)**

Regarding **claims 1 and 9**, AAPA discloses a mobile telephone device (see Page 1, lines 20-31), comprising:

an integrated circuit card with a subscriber identity module or a universal subscriber identity module, said card comprising a storage operable for storing at least one application (see Figure 1 and items 3A, 4A);

a device operable for remote access management of the card based on remote access message reception by mobile telephony (see Page 4, lines 12-35);

at least one data array manager (file manager, 2F) module for managing data arrays of at least one application stored in the card, said at least one data array manager (file manager) module comprising:

a receiver operable by a remote access message for receiving at least one instruction for operating on at least one piece of data contained in an array of a specified application (Figure 1, item 4A); an accessing device operable for accessing

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said array said accessing device further comprising a receiver operable for receiving from the specified application; the accessing device being operable for accessing said array; and apparatus operable for performing at least one operation (written, read or manipulate, see Page 4, lines 12-35); on said at least one piece of data (Figure 1, item 4D) in said array; but fails to teach an instruction and a requested reference for said array.

Nachef teaches that the card 2 can perform administration operations such as addition 201, deletion 202 and modification 203 followed by an interactive display on the screen; and proactive command (see Pars. [0006,0041-44 and 0080-0114]; whereby the interactive display and proactive command are equated with "instruction" and the "requested reference" is equated with the actual act of addition, deleting or modifying of file).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 2**, as recited in claim 1, Nachef's further teaching of deletion and modification operation on data or applets present in the Sim card (see Abstract), meets the claimed limitations of claim 2.

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef into the system of AAPA for the benefit of achieving a

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system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 3**, as recited in claim 1, AAPA discloses that said specified application is a SIM Application Toolkit or a Universal SIM Application Toolkit application (Toolkit application 3A and 4A, see Page 4, lines 12-35).

Regarding **claim 4**, as recited in claim 1, Nacheff's further teaching of deletion and modification operation on data or applets present in the Sim card (see Abstract), meets the claimed limitations of claim 4.

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nacheff into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 5**, as recited in claim 1, Nacheff's further teaching of deletion and modification operation on data or applets present in the Sim card (see Abstract), meets the claimed limitations of claim 5.

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nacheff into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

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Regarding **claim 6**, as recited in claim 5, Nacheff's further discloses the device, wherein said data array manager module is an Application Programming Interface (loader program consist of an applet programmed in JAVA, see Pars. [0040 and 0068]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nacheff into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 7**, as recited in claim 1, Nacheff's further discloses the device, wherein said device operable for remote access management is based on a GSM 03.48 standard or on a 3GPP 23.048 standard (see Par. [0019]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nacheff into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 8**, as recited in claim 3, AAPA further discloses that the device comprising a terminal supporting said Subscribe Identity Module (SIM) Application Toolkit or said Universal SIM Application Toolkit and also at least one of a supporting Data Download, and a class "e" terminal supporting the SIM Toolkit commands for channel management (see Page 4, lines 12-35).

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Regarding **claim 10**, as recited in claim 9, Nacheff's further teaching of deletion and modification operation on data or applets present in the Sim card (see Abstract), meets the claimed limitations of claim 10.

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nacheff into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 11**, as recited in claim 9, AAPA further discloses receiving said message in a terminal of subscriber equipment; sending said message from said terminal to the card; forwarding the instruction via a remote access manager module in the card to a data array manager module identified in the message (OTA messages are received in the subscriber equipment and transmitted to the card, where the remote access manager takes charge of performing the appropriate operation, see Page 4, lines 21-24).

Regarding **claim 12**, as recited in claim 11, Nacheff's further discloses that the message is of the Data Download type (see Pars. [0040-0044]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nacheff into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

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**4. Claims 13 and 15 are rejected under U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Nachef and further in view of Nachef (U.S. 20020137545 A1), (hereinafter Nachef II).**

Regarding **claim 13**, as recited in claim 12, the combination of AAPA and Nachef fail to teach sending of said message to the card by an ENVELOPE command.

Nachef II teaches sending of said message to the card by an ENVELOPE command (see Par. [0068]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef II into the system of AAPA and Nachef for the benefit of achieving an increased SIM card Toolkit applications via SIM smart card, thereby increasing processing speed (see Par. [0047]).

Regarding **claim 15**, as recited in claim 13, Nachef further discloses the method, wherein the instruction is forwarded to a data array manager module identified by a Toolkit Application Reference field of the message (see Par. [0063]).

**5. Claim 14 is rejected under U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Nachef and further in view of Arques et al. (U.S. 20040131083 A1), (hereinafter Arques).**

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Regarding **claim 14**, as recited in claim 11, the combination of AAPA and Nacheff fail to teach, wherein the message is sent to the card through a Bearer Independent Protocol-based channel.

Arques teaches wherein the message is sent to the card through a Bearer Independent Protocol-based channel (see Par. [0008]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Arques into the system of AAPA and Nacheff for the benefit of achieving a method for transmitting data in non-connected mode (see Par. [0018]).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Ritter (U.S. 6,914,154)** teaches a telecommunication method.

**Micheal et al. (U.S. 20050026635 A1)** teaches a telecommunication system.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

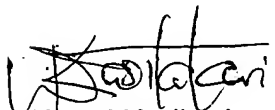
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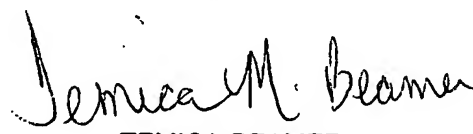
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kwasi Karikari  
Patent Examiner.

  
TEMICA BEAMER  
PRIMARY EXAMINER